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IN THE

Supreme Court of the United States

OCTOBER TERM, 1971

No. 71-671

WESTWOOD CHEMICAL, INC.,
Petitioner,

v.

OWENS-CORNING FIBERGLAS CORPORATION,
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

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I.

INTRODUCTORY STATEMENT

There is nothing about this ordinary patent case which warrants review by this Court.

The District Court held the TeGrotenhuis patents Nos. 2,742,378 and 2,841,566 invalid because

(a) the subject-matter was obvious to a person having ordinary skill in the art at the time the alleged inventions were made (35 U.S.C. § 103),

(b) the patentee did not invent the subject-matter thereof but instead derived it from others (35 U.S.C. § 102 (f)),

(c) the subject-matter was known to others and was disclosed in prior art patents before any date which the patents are entitled (35 U.S.C. §§ 102 (a) and 102 (g)), and

(d) the patents were not entitled to the benefit of the filing date of the original application and, hence, are admittedly invalid on other prior art.

The District Court also held the patents *not* infringed.

The Court of Appeals, after reviewing the findings below and the evidence, held the findings not clearly erroneous but supported by substantial competent evidence in the record and concurred on the invalidity of the patents for obviousness under 35 U.S.C. § 103 (App. 7a, 12a-13a).* It found it unnecessary to consider specifically either non-infringement or the other holdings of invalidity.

The petition (Pet. 9) allegedly is based on "the novelty and importance of the questions presented relating to the interpretation of the patent laws of the United States." However, the abstruse questions presented are neither novel nor important and *do not arise out of any of the holdings of the Courts below.*

There is no special or important reason why the writ prayed for should be granted.

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*App. — refers to the appendix to petitioner's brief; Pet. — refers to the Petition; C. A. App. — refers to the appendix in the Court of Appeals.

II.

THE QUESTIONS PRESENTED

Petitioner's statement of the questions presented ignores concurrent findings and conclusions of the Courts below, incorrectly assumes facts refuted by the record and the lower Court's findings, and completely misstates certain facts.

Questions Nos. 1 and 2 ignore and are destroyed by the fact that one of the pertinent prior art patents (the Steinman '268 patent) was *not* before and *not* considered by the Patent Office and that its disclosures are admittedly (Pet. 15) *not* in any of the patents considered by the Patent Office. The concurrent findings and conclusions as to obviousness in view of the Steinman '268 patent render these questions academic. Under all the authorities, the Court below was correct in holding (App. 10a) that the failure of the Patent Office to consider this patent "tends to weaken if not vitiate, the presumption of validity."

Moreover, the question of whether the Biefeld and Hyde patents (to which these questions are limited) were "pertinent" prior art depends not upon any finding by the District Court but (a) upon the effective date thereof (October 11, 1943) and (b) upon the entire disclosure contained therein — not merely one paragraph taken out of context by petitioner.

Question No. 3 raises no issue of law and misstates the facts. In reality, it asks this Court to review the evidence and the concurrent findings of the Courts below concerning the Steinman '268 patent based upon expert testimony. Even assuming, *arguendo,* that the chemical

compounds involved fall in different chemical classes, they are structurally similar and, more important, function the same, as both Courts below held on the basis of expert testimony (App. 43a, 11a-13a).

Question No. 4 poses no issue for this Court. It misstates the facts shown by the trial record and ignores the holdings of the Court of Appeals (App. 13a-14a) that petitioner had *failed* to show (a) that the rulings of the District Court on evidence were erroneous, (b) that petitioner's right of cross-examination was unduly limited, and (c) that petitioner did not have a fair trial.

III.

STATEMENT OF THE CASE

Petitioner's statement of the case is woefully inadequate and misleading and ignores facts found by the District Court and approved by the Court of Appeals.

Petitioner (Pet. 6) purports to set forth the contribution to the art made by TeGrotenhuis. The fact is that he made none. On the basis of the admissions made by TeGrotenhuis on cross-examination, the testimony of Dr. Rochow, Dr. Steinman, Dr. Biefeld and Mr. Philipps, and the prior art patents, the District Court found that "TeGrotenhuis made no contribution to relevant art involved in this suit" (App. 49a); and the Court of Appeals agreed (App. 12a).

Both of the TeGrotenhuis patents in suit relate to the treatment of fillers, pigments and fibers with an organo silicon compound referred to as a coupling agent which forms a bond with the filler, pigment or fiber and with a polyester resin into which the reinforcing material is placed. The '378 patent is addressed to the use of vinyl silanes as the coupling agent and the '566 patent is addressed to a coupling agent having an alkenyl group other than vinyl, and specifically the allyl silanes.

Glass fibers had been developed as a commercial product prior to the advent of unsaturated polyester resins during World War II; and glass fiber reinforced plastics or resins have been on the market since about 1940 (App. 20a). Glass fibers had been used for reinforcing other resinous materials, for example, phenolic resins, and, therefore, it was "logical" that glass fibers

would be used to reinforce the newly developed unsaturated polyester resins (App. 20a).

It had been recognized that the strength of glass fiber resin laminates could be increased if the glass fiber, an inorganic material, could be made more compatible with the resin, an organic material. Research was conducted by Owens-Corning in 1942 to determine what materials would react with the glass surface and make the glass more compatible with organic resins (App. 20a). It was found that the surface of glass fibers had between 50 and 300 molecular layers of water held to the surface through hydrogen bonds. It was determined that if material having the desired properties could be made to react with the hydroxyl groups on the glass surface the materials could be bonded to the glass surface, thereby altering the surface characteristics of the glass and imparting to the glass surface the desired property (App. 20a-21a).

Prior to this work, Dr. Rochow at General Electric had discovered that methylchlorosilane could be prepared; and his colleague, Patnode, determined that the methylchlorosilane reacted with the water adsorbed on the glass surface to establish a thin film or layer of methylsiloxane on the glass surface (App. 21a). Thus, the organic silicon compounds were obvious materials to use in treating glass fibers.

Dr. Steinman and others at Owens-Corning began the use of organic silicon compounds in treating glass fibers (App. 21a-22a). It was found that chlorosilane would react with the hydroxyls on the glass surface, and this brought about the beginning of the "double fishhook" concept, which is that one end of the coupling

agent reacts with the glass fiber surface and the other end reacts with the resin by copolymerization (App. 21a-22a). Dr. Steinman proposed unsaturated organo silicon compounds and, by mid-February, 1943, he had disclosed this concept of using allyl silanes and allyl silicates as coupling agents to bond glass fibers to laminating resins (App. 22a). The allyl silanes were not available commercially at that time, but Dr. Steinman immediately requested some from Dow Corning but was unable to get them until mid-1945. However, Dr. Steinman continued his work by applying his double fishhook concept utilizing the allyl silicates; and glass fiber reinforced plastics using the allyl silicates were made and evaluated and it was found that they improved the physical properties of polyester laminates by thirty to forty percent in compression, flexure and tensile strength (App. 22a). These allyl silicates are structurally similar to and, as both Courts below found, they are functionally the same as the allyl and vinyl silanes (App. 22a-23a, 11a). The strong performance of the allyl silicates gave impetus to obtaining the allyl silanes because it was expected that they would perform better (App. 23a). Dr. Steinman and his associates at Owens-Corning, in mid-1945, obtained unsaturated silanes, tested them and obtained the expected good results (App. 23a). Owens-Corning immediately proceeded with the commercial use of allyl silanes and later when vinyl silanes became available it used them (App. 23a-24a).*

TeGrotenhuis, petitioner's alleged inventor, at all times pertinent, was a patent attorney practicing in Cleveland and also a chemical consultant (App. 25a).

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*It also has used and continues to use the other coupling agents mentioned in F.F. 10 (App. 19a).

From late 1941 until November, 1944, he worked on the preparation of a synthetic rubber latex and reinforcing it with carbon black and other inorganic solids (App. 25a). He did no work with glass fibers or with unsaturated polyester resin.

On November 15, 1944, TeGrotenhuis attended a lecture given by Dr. Rochow, in which Dr. Rochow described and demonstrated the properties of the organo silane compounds, pointing out that organo chlorosilanes would hydrolyze and, therefore, when brought into contact with the glass surface would react with the water adsorbed on the glass surface and deposit a highly water-repellent film of an organic siloxane which was attached to the glass (App. 25a-26a). Dr. Rochow also taught him that the treated surfaces became compatible with organic compounds (App. 29a). He taught him that the unsaturated groups of the organo silanes would react and copolymerize with various resins — a feature which was well known at this time to those working in the art (App. 26a, 29a).

On the night of the lecture, TeGrotenhuis wrote a memorandum proposing to treat pigments for rubber, paints, printing inks and the like with silanes (App. 26a). That memorandum made no reference to the treatment of glass, or to polyester resins, or to glass fiber reinforced polyester resins (App. 26a). Thereafter, TeGrotenhuis commenced the preparation of an application and worked on it sporadically until it was filed on March 30, 1945. That application failed to mention or even allude to glass or glass fiber reinforced polyester resins (App. 27a-28a). The first mention of glass fiber or glass fiber reinforced polyester resins in a United States patent application filed by TeGrotenhuis was in

one filed in 1951 (App. 27a-28a). Long prior to that time, Dr. Steinman and Owens-Corning had been using the allyl silanes and had commercialized glass fibers treated therewith for use in reinforcing polyester resins (App. 23a-24a).

The District Court's finding (App. 49a) that TeGrotenhuis "made no contribution" to the art is supported by a plethora of evidence (App. 26a-27a). Thus, this Court's holding in *Graham v. John Deere Co.*, 383 U.S. 1, 6, is applicable:

> "Innovation, advancement, and things which add to the sum of useful knowledge are inherent requisites in a patent system which by constitutional command must 'promote the Progress of . . . useful Arts.' This is the *standard* expressed in the Constitution and it may not be ignored."

TeGrotenhuis merely filed an application in 1945 (which does not adequately disclose the claimed subject-matter of the patents in suit) and added to his original application from time to time by filing a series of applications based on commercial developments in the art by others. TeGrotenhuis qualifies as one of the "speculative schemers" referred to in *Atlantic Works* v. *Brady*, 107 U.S. 192, 202 (1882).*

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*None of those applications were available to the public until the patents issued and by that time the alleged inventions had been developed and placed in commercial use by others including the respondent.

IV.

ARGUMENT

Sufficient has already been stated to show that the petition herein should be denied. However, there are several facets of petitioner's inapt and abstruse "questions presented" on which further comment should be made.

As to Question No. 1.

This question seems to be predicated on the thought that the Court below vitiated the presumption of validity (35 U.S.C. §282) solely on the basis of teachings of the prior art patents which, in effect, were before and considered by the Patent Office. This is factually incorrect.

The Court below (App. 5a) was fully aware of Section 282 and that a "heavy burden of proof" rests on the party attempting to prove invalidity. The Court also recognized and stated (App. 10a) that the District Court had properly before it "three significant prior art patents . . . which were not considered by the patent examiner" and that the failure of the Patent Office to consider pertinent prior art "tends to weaken if not vitiate, the presumption of validity." The Patent Office did not have before it the Hyde patent No. 2,390,370 or the Biefeld patent No. 2,392,805. The fact that a portion of the language appearing in the Biefeld and Hyde patents also appears in patents which were before the Patent Office is immaterial. That language is only part of the disclosures of these two patents; and the similar language is used in different contexts in the Hyde and Biefeld patents than in the Johannson patents which

were before the Patent Office. Both the District Court and the Court of Appeals relied, *inter alia*, on disclosures in these patents not contained in the Johannson patents (App. 36a-38a, 11a-12a).*

Petitioner, in discussing this question, ignores the fact that the Courts below *also* relied upon the Steinman '268 patent and held the alleged inventions obvious in view of its disclosures and the expert testimony based thereon and that no part of this patent was before or considered by the Patent Office (App. 10a-11a, 42a-43a):

Underlying this question is the thought that a holding of obviousness should not be based upon prior art patents which were before the Patent Office in view of § 282. This is plainly wrong. The presumption is rebuttable; and where, as here, the evidence clearly shows that the subject-matter claimed was obvious to those skilled in the art and that there was "an absence of that degree of skill and ingenuity which constitutes essential elements of every invention" (App. 12a-13a), a holding of invalidity is required under the law as enunciated by this Court and others. This Court, in *Graham et al. v. John Deere Co.*, 383 U.S. 1 (1966), held the Graham patent invalid for obviousness on the basis of a patent which had been considered by the Patent Office and a prior use clamp not before the Patent Office. And in *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969), this Court likewise held the patent

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*Dr. Rochow testified without contradiction that he had examined the file wrapper histories of the patents in suit and found nothing therein even indicating that the Patent Office examiner understood important disclosures in the patents which were considered by the Patent Office (C.A. App., Vol. 10, pp. 2034-36).

in suit invalid for obviousness in view of a patent which was considered by the Patent Office and another patent which was not. In *Kell-Dot Industries, Inc. v. Graves,* 361 F. 2d 25, 30 (8 Cir., 1966), Cert. Den. 385 U. S. 842, the Court held the patent in suit invalid under § 103 in view of the prior art which was before the Patent Office.*

Petitioner's question assumes (Pet. 10) that the quoted paragraph of the Biefeld and Hyde patents is the only portion of those patents relied upon by the Court. This is incorrect. The whole context from which the quoted paragraph was taken was relied upon by the Courts below (App. 36a-37a, 11a-12a). Petitioner also says (Pet. 10) that the significance of this exact language being in patents before the Patent Office "completely eluded both the trial court and the Sixth Circuit." This again is incorrect. The Court of Appeals recognized that the language was in the Johannson patents Nos. 2,436,304 and 2,557,786, and that these were before the Patent Office (App. 7a-9a).

Petitioner also argues (Pet. 12, 15) that the Courts below failed to "give any cognizance to the interference proceeding" in which the '378 patent was involved. This is incorrect. Both Courts (App. 45a-46a, 4a) were fully cognizant of that proceeding and the sole question (i. e.,

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*See also *L & A Products, Inc. v. Britt Tech Corporation,* 365 F.2d 83, 87 (8 Cir., 1966); *Straussler* v. *United States,* 339 F.2d 670, 671 (Ct. Cl., 1964); *National Filters, Inc.* v. *Research Products Corporation,* 384 F.2d 516, 520 (5 Cir., 1967); *Decca Limited* v. *United States,* 420 F.2d 1010, 1027 (Ct. Cl., 1970); Cert. Den. 400 U.S. 865; *Richmond Screw Anchor Co., Inc.* v. *Superior Concrete Accessories, Inc.,* 256 F.2d 232 (2 Cir., 1958); *Allen v. Ideal Products, Inc. et al.,* 426 F.2d 185, 186 (3 Cir., 1970).

priority) involved therein. That proceeding did not and could not involve the question of patentability because the TeGrotenhuis patent had issued and patentability cannot be questioned in an interference proceeding involving an issued patent. Therefore, *Hildreth* v. *Mastoras*, 257 U. S. 27 (1921) and *Radio Corp. v. Radio Laboratories*, 293 U. S. 1 (1934) are totally inapplicable and are not in conflict with the decisions below, as petitioner suggests.

As to Question No. 2.

In this question, petitioner again ignores the concurrent findings as to obviousness based upon the Steinman '268 patent and the expert testimony in regard to the significance of that disclosure. Those findings alone and the evidence on which they are based destroy and render irrelevant this question as well as question No. 1, and demonstrate that the questions posed do not arise out of any holdings of the Courts below.

Petitioner argues (Pet. 13) that the Court of Appeals "felt itself bound to affirm the *conclusion* of the trial court below as not being clearly erroneous on the basis of Rule 52(a) F.R.C.P."* This is incorrect. The Court of Appeals held that "the District Court's *findings of fact* as to the teachings of these [prior art] patents are not clearly erroneous" (App. 7a) and that the "factual determinations on the status of the prior art are not clearly erroneous" (App. 12a); and it also stated that "there is substantial competent evidence in the record which supports the District Court's conclusions of law" (App. 7a). The Court of Appeals also stated

*Emphasis ours throughout this brief except where noted otherwise.

"Our review confirms the legal correctness" of the lower Court's conclusion as to obviousness (App. 12a-13a). The Court below went on to say that the "secondary indicia" cannot save the patentability of an invention "when it clearly appears, as in this case, that the invention was obvious to one skilled in the art" (App. 13a).

Thus the Court correctly applied the proscriptions of Rule 52(a) and arrived at the same legal conclusion as to invalidity as the District Court.

In regard to the "clearly erroneous" provisions of Rule 52(a), this Court, in *Graver Mfg. Co.* v. *Linde Co.*, 336 U.S. 271, 274-75 (1949) said:

> "To no type of case is this last clause more appropriately applicable than to the one before us, where the evidence is largely the testimony of experts as to which a trial court may be enlightened by scientific demonstrations. . . . .
>
> "The rule requires that an appellate court make allowance for the advantages possessed by the trial court in appraising the significance of conflicting testimony and reverse only 'clearly erroneous' findings."

And on rehearing of the *Graver* case, 339 U.S. 605, 609-10 (1950), this Court stated:

> "Like any other issue of fact, final determination requires a balancing of credibility, persuasiveness and weight of evidence. It is to be decided by the trial court and that court's decision, under general principles of appellate review, should not be disturbed unless clearly erroneous. Particularly is this so in a field where so much depends upon familiarity with specific scientific problems and principles not usually contained in the general storehouse of knowledge and experience."

Argument.

Petitioner argues (Pet. 13-14) that there is "confusion in the circuits" as to the sufficiency of the evidence to invalidate a patent, and asks whether the burden is by clear and convincing evidence. Different Courts have used somewhat different language in defining that burden, but the point is completely academic in this case because the Court of Appeals followed this Court's decisions and recognized that the burden is a "heavy" burden, and cited the *Ever-Wear* case (427 F.2d 373), which points out that (as to novelty) clear and cogent evidence is required.

As to Question No. 3.

Petitioner's third question, which relates solely to the prior art Steinman '268 patent, poses no issue in this case and ignores the facts and the express findings of both Courts below.

The District Court (App. 42a-43a) made extensive findings in regard to the disclosure of the Steinman '268 patent, and considered expert testimony in regard thereto and found that the allyl silicates disclosed by Steinman, while not identical with materials presently used, were "structurally similar" and that they "function in the same manner" as the allyl silanes and the vinyl silanes of the patents in suit. The Court of Appeals (App. 10a-11a) carefully reviewed the District Court's findings and held these "factual determinations" not clearly erroneous.*

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*Whether the allyl silicates are in a "different class of chemicals" from the vinyl and/or allyl silanes is wholly irrelevant since they are structurally similar and "function in the same manner," as the Courts below held.

Argument.

Petitioner argues (Pet. 16-17) that there is no evidence to show that the Steinman patent was not before and considered by the examiner. The fact is that the file wrapper histories which are in evidence (PXs-5, 7, 9, 10) show conclusively that the Steinman patent was not cited by the patent examiner. Moreover, the Court of Appeals found as a fact that the patent was "not considered by the patent examiner."

Petitioner even asserts (Pet. 16, footnote 6) that plaintiff "never contended he could use any silicate." This is not so. In his 1945 application, TeGrotenhuis disclosed as an example of "suitable organo-substituted silicon halides for the present invention" the alkoxy silicon halides which are the silicates (C. A. App. Vol. 2, p. 176).

Petitioner argues (Pet. 18) that "every expert . . . agreed in the record that the chemical combinations of the Steinman patent cannot and do not function in the same way as the chemical combinations" of the patent in suit. This is incorrect and is contrary to express findings based on "expert testimony" that the allyl silicates of Steinman are functionally the same (App. 42a-43a, 11a).

As to Question No. 4.

This question is based on a completely incorrect premise and ignores the express holdings of the Court of Appeals that petitioner *failed* to show that it was denied a fair opportunity to produce rebuttal evidence and was unduly restricted on cross-examination (App. 13a-14a).

Conclusion.

The arguments and assertions made here by petitioner were made to the Court of Appeals. In fact, fifteen pages and an addendum of ten pages in petitioner's brief before the Court of Appeals were devoted to this matter of fair trial. The Court of Appeals specifically considered and resolved the "fair trial issue" against petitioner. Petitioner has presented nothing new on this matter which was not considered by the Court of Appeals.

V.

CONCLUSION

The petition should be denied.

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